

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR DALE BURNS

Appeal 2006-2388
Application 09/603,510
Technology Center 1700

Decided: February 23, 2007

Before MURRIEL E. CRAWFORD, ROBERT E. NAPPI and ANTON W. FETTING, *Administrative Patent Judges*.

ANTON W. FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-22, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We REVERSE and ENTER A NEW GROUND OF REJECTION PURSUANT TO 37 CFR § 41.50(b).

BACKGROUND

The appellant's invention relates to a student loan consolidation qualification system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A computer system for student loan consolidation qualification, comprising:

an input module embodied in software in said computer system and associated with an Internet site, that presents at least one page to a loan applicant to assist said loan applicant in providing personal and student loan information pertaining to a plurality of student loans made to said loan applicant; and

a qualification module embodied in software in said computer system and associated with said input module, that assesses said personal information to determine a personal qualification of said loan applicant and assesses said student loan information pertaining to said plurality of student loans to determine a loan qualification of said loan applicant, said qualification module qualifying said loan applicant and informing said loan applicant and a loan consolidator only if said personal qualification and said loan qualification are positive.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mottola	US 5,745,885	Apr. 28, 1998
Tengel	US 5,940,812	Aug. 17, 1999
Levine	US 6,233,566 B1	May 15, 2001 (Mar. 19, 1999)

We also make the following art of record.

General Accounting Office, Health, Education and Human Services Division,
Student Loans: Improvements in the Direct Loan Consolidation Process,
GAO/HEHS-99-19R, 26p. 11/10/1998 (GAO)

REJECTION

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Tengel, Levine and Mottola.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (mailed February 9, 2006) for the reasoning in support of the rejection, and to appellant's brief (filed December 5, 2005) and reply brief (filed April 10, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Claims 1-22 rejected under 35 U.S.C. § 103(a) as obvious over Tengel, Levine and Mottola.

We note that the appellant argues these claims as a group. Accordingly, we select claim 1 as representative of the group.

The issues under contention are

- Whether the art describes a page to a loan applicant to assist in providing personal and student loan information pertaining to student loans.
- Whether the art describes software that assesses personal information to qualify the applicant and the student loans.
- Whether the art describes informing the loan applicant and a loan consolidator only if the applicant and the loans qualify.

The appellant argues that Tengel does not address student loans or loan consolidation, that Levine does not overcome these shortcomings, and that Mottola, although directed toward student loans, has no description of loan consolidation (Br. 7-11; Reply Br. 2-3).

The facts pertinent to these issues are:

Tengal describes a page to a loan applicant to assist in providing personal and outstanding loan information pertaining to existing loans

This loan application form asks the potential borrower to enter various information about the borrower such as the loan product the borrower is applying for, the gross income of the borrower, current monthly debt payments by the borrower, and so on.

(Col. 8, Lines 50-58).

Tengal describes software that assesses personal information to qualify the applicant and the loans.

If the borrower attributes provided by the potential borrower and the credit bureau are within the loan acceptance criteria as specified by the lender for an offered loan, then that loan is available to the potential borrower. On the other hand, if the borrower attributes are outside the loan acceptance criteria, then that loan is not available to the potential borrower.

(Col. 9, Lines 23-29).

Tengal describes informing the loan applicant and a loan provider only if the applicant and the loans qualify.

The rankings of best loans are displayed to the potential borrower on the screen . . . the loan origination system of the present invention automatically generates a loan application from the borrower attributes of the potential borrower (step 220). This loan application is then sent via the global telecommunications network to that lender for loan approval.

(Col. 9, Line 55 – Col. 10, Line 11).

Levine describes, as background, loan consolidation of high-loan-to-value (HLTV) loans typically obtained by consumers using home equity. (Col. 1, Lines 40-52).

Levine describes the motivation for consolidating loans as lowering the borrower's monthly payments and repaying debts more quickly, because interest on home equity loans may be tax deductible and the interest rate on home equity loans may be lower than the loans that are being consolidated. (Col. 2, Lines 1-12).

Levine is directed toward a system for trading financial products. (Col. 1, Lines 12-15).

Levine describes student loans as a species of the genus of loans its system may trade. (Col. 7, Lines 30-38).

Mottola describes a system for consolidating the individual student loans of a number of debtors into a unit trust (Col. 3, Lines 39-66).

None of the references, Tengal, Levine or Mottola, describe consolidating plural student loans owed by a debtor or communicating qualifying results to a consolidator.

Thus, we must conclude that, although Tengal describes a page to a loan applicant to assist in providing personal and outstanding loan information pertaining to existing loans; software that assesses personal information to qualify the applicant and the loans; and informing the loan applicant and a loan provider only if the applicant and the loans qualify, none of the references describe consolidating plural student loans owed by a debtor or communicating qualifying results to a consolidator. Therefore the examiner has not made a prima facie case for obviousness because all of the claimed elements have not been shown in the art applied.

Accordingly we do not sustain the examiner's rejection of claims 1-22 under 35 U.S.C. § 103(a) as obvious over Tengal, Levine and Mottola.

NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b)

Pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection:

Independent claims 1, 9 and 16 are rejected under 35 U.S.C. § 103 as obvious over Tengal and GAO.

Tengal describes a page to a loan applicant to assist in providing personal and outstanding loan information pertaining to existing loans; software that assesses personal information to qualify the applicant and the loans; and informing the loan applicant and a loan provider only if the applicant and the loans qualify (See facts pertinent to the issues above). GAO describes the process of consolidating plural student loans on p. 5, including the steps in which:

- The borrower lists each loan to consolidate.
- A clearing house, Electronic Data Systems (EDS), qualifies the borrower and the loans by contacting each of the lenders.
- The clearing house, EDS, transmits data to the consolidator only after all of the data has been qualified by paying off the underlying loans.

Thus, GAO describes consolidating plural student loans owed by a debtor or communicating qualifying results to a consolidator. It would have been obvious to a person of ordinary skill in the art to have applied Tengal's automation of loan origination to GAO's student loan consolidation process for Tengal's taught advantages of automation.

CONCLUSION

To summarize,

- The rejection of claims 1-22 under 35 U.S.C. § 103(a) as obvious over Tengel, Levine and Mottola is not sustained.
- Pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection
 - Independent claims 1, 9 and 16 are rejected under 35 U.S.C. § 103 as obvious over Tengel and GAO.


This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50 (b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims: (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner


(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

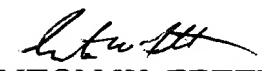
REVERSED
and
NEW GROUND OF REJECTION PURSUANT TO 37 CFR § 41.50(b)



MURRIEL E. CRAWFORD
Administrative Patent Judge



ROBERT E. NAPPI
Administrative Patent Judge



ANTON W. FETTING
Administrative Patent Judge

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